

Appl. No. 10/620,880
Amdt. Dated January 16, 2006
Reply to Office Action of June 15, 2005

• • R E M A R K S / A R G U M E N T S • •

The Official Action of June 15, 2005 and the Advisory Action of September 26, 2005 have been thoroughly studied. Accordingly, the changes presented herein for the application, considered together with the following remarks, are believed to be sufficient to place the application into condition for allowance.

By the present supplemental amendment the claims have been amended in the manner previously proposed in applicants' Amendment After Final filed September 7, 2005. That is, claims 6 and 7 have been amended to recite that the units of hardness of the elastomeric polymer are "JIS A." which is consistent with evaluation methods and measured hardness discussed on page 10 of applicants' specification.

Also, step d) has been deleted from claim 21.

Entry of the changes to the claims is respectfully requested.

On page 2 of the Official Action mailed June 15, 2005 the Examiner objected to applicants' amendment filed March 25, 2005 under 35 U.S.C. §132(a) on the basis that the recitation of "Duro A hardness" involved new matter.

In response to this objection claim 6 and 7 have been amended to recite "JIS A" hardness which is measured on page 10 using the referenced standardized JIS testing methods.

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On page 3 of the Office Action the Examiner has objected to Claim 21 on the basis that the Examiner considered step d) as being directed to a method of using the gasket rather than a method of producing the gasket.

In response to this objection to claim 21, claim 21 has been amendment to delete step d).

Claims 2-9 and 21 are pending in this application.

Claims 21 and 2-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over European Patent Application No. EP 1 220 345 to Nagai in view of U.S. Patent No. 4,337,332 to Melancon et al.

In response to the Examiner's reliance upon European Patent Application No. EP 1 220 345 to Nagai, applicants submitted a Certified Copy and verified English translation of JP 119408/1999 to which priority of the present application is claimed under 35 U.S.C. §119 on September 7, 2005.

The submission of the Certified Copy and verified English translation of JP 119408/1999 perfects applicants' claim to priority under 35 U.S.C. §119 so that the present application enjoys the priority date of April 4, 1999.

European Patent Application No. EP 1 220 345 to Nagai enjoys a priority date of September 1, 1999 which is later than the perfected priority date the present application currently enjoys.

Moreover, European Patent Application No. EP 1 220 345 to Nagai was not published until March 8, 2001.

It accordingly follows that European Patent Application No. EP 1 220 345 to Nagai is no longer available to the Examiner as a prior art reference in the present application.

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It is noted that the Examiner courteously suggested that applicants' perfect their claim to the priority date of JP 119408/1999 in the paragraph bridging pages 2 and 3 of the Official Action.

Applicants have, with appreciation, taken the Examiner's suggested advice.

In the Advisory Action of September 26, 2005 the Examiner expressed concerns that the Certified Copy and verified English translation of JP 119408/1999 did not seem to disclose any limitations of step "C" of independent claim 21: the addition type silicone rubber comprising: (A) 100 parts by weight of an alkenyl group-containing organopolysiloxane and (B) such an amount of organohydrogenpolysiloxane having at least 2H atoms directly bonded to a Si atom in one molecule as to make 0.4 - 5.0 parts of the H atom to one part of the alkenyl group of component (A), and the adhesive component comprising (C) an organosilicone compound having at least one H atom directly bonded to a Si atom.

The Examiner noted that "[t]hus the applied reference is still considered a valid teaching."

Upon receipt of the Advisory Action, the undersigned studied and compared the Certified Copy and verified English translation of JP 119408/1999 with applicants' originally filed U.S. specification/disclosure.

It came to the undersigns' attention that the Certified Copy and verified English translation of JP 119408/1999 used an adhesive silicone rubber in Example 1 that was identified by product X-34-1277A/B available from Shin-Etsu Chemical Co., Ltd.

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Similarly, applicants' specification (on page 5) references the use of adhesive silicone rubbers that are available from Shin-Etsu Chemical Co., Ltd. and identified by product references X-34-1277, X-34-1547, X-34-1427, X-34-1464, X-34-1535 and X-34-1534.

The undersigned contacted Shin-Etsu Chemical Co., Ltd. and inquired as to whether or not their adhesive silicone rubber products met the limitations of step "C" of applicants' independent claim 21.

Although the undersigned contacted Shin-Etsu Chemical Co., Ltd via facsimile and received a telephone call from one of the company's U.S. legal represents, the undersigned was unsuccessful at obtaining the necessary product information requested.

It subsequently became necessary to file a Notice of Appeal to maintain the pendency of the present application until such product information could be obtained.

On January 11, 2006 the undersigned received the attached product information materials from Shin-Etsu (labeled as Exhibit A).

Exhibit A is a product brochure on Shin-Etsu's silicon LIMS (Liquid Injection Molding System).

On page 4 of Exhibit A X-34-1277 A/B is described.

On the lower portion of page 3 of Exhibit A the curing mechanism of X-34-1277 A/B is illustrated.

The curing mechanism shown on page 3 of Exhibit A is the same curing mechanism that is described on page 6 of applicants' originally filed U.S. specification/disclosure.

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Because both the X-34-1277 A/B in Exhibit A and the adhesive silicone rubbers of the present invention (exemplified by the Shin-Etsu products) have the same curing mechanism, it can be concluded that they have the same basic compositions and fall within the limitations of applicants' claimed invention.

Moreover, it is noted that the Shin-Etsu product X-34-1277 specifically identified on page 5 of applicants' originally filed U.S. specification/disclosure directly correspond to X-34-1277 A/B and encompass both X-34-1277 A and X-34-1277 B, it being understood that the A and B are products from the same series with different viscosities as noted on the attached Exhibit B (LIMS (Liquid Injection Molding System): Selective Self-Adhesive Liquid Silicone))

It is believed that the Exhibits A and B and the comments set forth above establish that the present application enjoys a priority date for the claimed subject matter in independent claim 21 which predates European Patent Application No. EP 1 220 345 to Nagai.

Accordingly European Patent Application No. EP 1 220 345 to Nagai has been removed from being a prior art reference in this application, and the outstanding rejection of the claims as being unpatentable over European Patent Application No. EP 1 220 345 to Nagai in view of U.S. Patent No. 4,337,332 to Melancon et al. should properly be withdrawn.

Entry of the present amendment together with the Certified Copy and verified English translation of JP 119408/1999 and Exhibits A and B and an early allowance of the application are respectfully requested.

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It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved; the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



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